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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,928

07/13/2006

Ilan Ziv

P-8972-US

8877

49443 7590 01/06/2010  
Pearl Cohen Zedek Latzer, LLP  
1500 Broadway  
12th Floor  
New York, NY 10036

EXAMINER

SAMALA, JAGADISHWAR RAO

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

01/06/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,928	<b>Applicant(s)</b> ZIV ET AL.	
	<b>Examiner</b> JAGADISHWAR R. SAMALA	<b>Art Unit</b> 1618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 28-69 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

**DETAILED ACTION**

**DETAILED ACTION**

According to a preliminary amendment filed on 07/13/2006, the applicant has cancelled claims 1-27 and furthermore, new claims 28-69 have been added.

Claims 28-69 are pending in the instant application.

**Election/Restrictions**

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 28-31 and 45, drawn to a method for targeting a compound to a cell undergoing perturbation of the normal organization of its plasma membrane (PNOM-cell), comprising contacting a cell population comprising said PNOM-cell with a compound or a conjugate comprising a compound of formulae I and II.

Group II, claim(s) 32- 44 and 46-54, drawn to a compound represented by the structure in formula II-VII, IX-XI and XIII-IV, wherein D is a marker for diagnostic or a drug.

Group III, claim(s) 55, drawn to a pharmaceutical or diagnostic composition, comprising an active ingredient of a compound of any of the formulae III-VII, IX, X, XIII or XIV.

Group IV, claim(s) 56-62, drawn to a method for targeting a compound to a cell undergoing perturbation of the normal organization of its plasma membrane (PNOM-cell), comprising contacting a cell population comprising said PNOM-cell with a compound or a conjugate comprising a compound of formulae III-VII, IX-XI, XIII or XIV.

Group V, claim(s) 63, drawn to a method for detecting a PNOM-cell within a cell population, said method comprising: contacting the cell population with a compound or a pharmaceutical composition comprising said compound of formulae I-VII, IX-XI, XIII-XIV.

Group VI, claim(s) 64-66, drawn to a method for imaging PNOM-cells in a subject, human or animal comprising: administering to said subject a compound or pharmaceutical composition comprising said compound of formulae I-VII, IX-XI, XIII-XIV.

Group VII, claim(s) 67, drawn to a method for targeting a cytotoxic drug to a tumor which has cells undergoing cell death, said method comprising the step of administering said compound of formulae I-VII, IX-XI, XIII-XIV comprising or being linked to the cytotoxic drug, thereby targeting of the cytotoxic drug to the cells undergoing cell death within the tumor.

Group VIII, claim(s) 68-69, drawn to a PMBC-PET precursor, represented by a structure as set forth in any of the formulae I-III, V-VI, IX-XI XIII or XIV, comprising or

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being linked to a moiety to be substituted by an  $^{18}\text{F}$  radio-isotope upon radio-labeling, thereby generating an  $^{18}\text{F}$ -labeled compound.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is drawn to a method for targeting a compound to a cell undergoing perturbation of the normal organization of its plasma membrane (PNOM-cell), comprising contacting a cell with compounds of formulae I and II. Group II is drawn to different compounds represented by the structure in formulae II-VII, IX-XI and XIII-IV, wherein D is a marker for diagnostic or a drug. Group III. Group IV is drawn to a method for targeting a compound to a cell undergoing perturbation of the normal organization of its plasma membrane (PNOM-cell) with different compound with respect to Group I. Group V is drawn to a method for detecting a PNOM-cell in a subject. Group VI is drawn to a method for imaging PNOM-cells in a subject. Group VII is drawn to a method for targeting a cytotoxic drug to a tumor which has cells undergoing cell death. Group VIII is drawn to a PMBC-PET precursor. All the eight groups are different inventions. Therefore there is no special technical feature for the compounds, the method for targeting the compounds or the different field of application of the compounds. Also there is no unity of invention.

There is no common core which in the Markush Practice, is a significant structural element shared by all of the alternatives; see PCT Administrative Instructions Annex B Part I (F)(i) (B)(1).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGADISHWAR R. SAMALA whose telephone number is (571)272-9927. The examiner can normally be reached on 8.30 A.M to 5.00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jagadishwar R Samala/

Examiner, Art Unit 1618

/Jake M. Vu/

Primary Examiner, Art Unit 1618

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